

### **REMARKS/ARGUMENTS**

Claims 1 and 3-8 are pending in the application. By this amendment, claim 1 is being amended to advance the prosecution of the application, without the addition of new matter. Entry of this amendment as placing the application in condition for allowance or alternatively in better form for appeal, and reconsideration and allowance in view thereof, are respectfully requested.

In paragraph 2 which begins on page 2 of the Office Action, claim 1 is rejected under 35 U.S.C. §.103(a) as being unpatentable over U.S. Patent 6,052,347 of Miyata in view of U.S. Patent 6,404,712 of Lee et al. or U.S. Patent 6,646,965 of Kim. In paragraph 3 which begins on page 3 of the Office Action, claims 3-5 are rejected under 35 U.S.C. §. 103(a) as being unpatentable over Miyata and Lee or Kim, and further in view of U.S. Patent 6,134,209 of Den Boef. In paragraph 4 which begins on page 4 of the Office Action, claim 6 is rejected under 35 U.S.C. §. 103(a) as being unpatentable over Miyata and Lee (or Kim) as applied to claim 1 and further in view of U.S. Patent 5,321,679 of Horiguchi. In paragraph 5 which begins on page 5 of the Office Action, claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyata, Lee (or Kim) and Horiguchi, as applied to claim 6, and further in view of JP 58164059 A of Inaba. In Paragraph 6 which begins on page 5 of the Office Action, claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyata, Lee (or Kim) and Horiguchi, as applied to claim 6, and further in view of U.S. Patent 4,788,672 of Toyooka et al. These rejections, which are essentially a repeat of the claim rejections set forth in the prior Office Action, are again respectfully traversed, particularly in view of claim 1 as amended herein.

In applicant's prior response of October 6, 2004, applicant pointed out that in accordance with the present invention, and as recited in claim 1, "said trial writing region, a buffer region, a lead-in region, a program region, and a lead-out region are disposed in order from the inner peripheral side of said optical disk toward the

outer peripheral side, and said outer peripheral region is disposed outside the lead-out region" (emphasis added). Applicant then pointed out that the secondary references, and particularly Lee which is relied on most heavily, do not disclose or suggest this important feature in accordance with the invention. While Lee discloses a lead-in region, a program region and a lead-out region, such reference does not disclose or suggest that "said outer peripheral region is disposed outside the lead-out region" as recited in claim 1. The same is true of the other references as well.

In the examiner's response to applicant's arguments which is set forth in paragraph 8 which begins on page 6 of the Office Action, the examiner again acknowledges that Miyata "does not disclose the presence of a buffer region, a lead-in region, and a lead-out region", and that when such reference is viewed alone, it is silent or does not explicitly disclose "that said outer peripheral region is disposed outside the lead-out region". However, the examiner goes on to state that claim 1 is obvious in view of the prior art, and notes in particular that the secondary references of Lee and Kim inherently disclose an outer peripheral region disposed outside a lead-out region.

Applicant again traverses such argument, but points out that claim 1 as now amended herein even more clearly distinguishes patentably over the prior art. As amended herein, and in addition to the limitations previously pointed out, claim 1 now contains the recitation "wherein test data is written onto or read from the trial writing region disposed on the innermost peripheral side of said optical disk and the trial writing region disposed outside of the lead-out region". None of the cited references disclose or suggest such feature in accordance with the present invention. Nor could the references be combined to render such feature obvious, again in view of the clear absence of the feature from each and every one of the

references. Therefore, claim 1 as amended herein is submitted to clearly distinguish patentably over the prior art.

Claims 3-8 depend directly or indirectly from and contain all of the limitations of claim 1, so that such claims are also submitted to clearly distinguish patentably over the prior art.

In conclusion, claims 1 and 3-8 are submitted to clearly distinguish patentably over the art for the reasons discussed above. Therefore, entry of this amendment under the provisions of 37 C.F.R. §. 1.116 as placing the application in condition for allowance or alternatively in better form for appeal, and reconsideration and allowance in view thereof, are respectfully requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 337-6700 to discuss the steps necessary for placing the application in condition for allowance.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,  
HOGAN & HARTSON L.L.P.

Date: January 31, 2005

By: 

John P. Scherlacher  
Registration No. 23,009  
Attorney for Applicant(s)

500 South Grand Avenue, Suite 1900  
Los Angeles, California 90071  
Phone: 213-337-6700  
Fax: 213-337-6701